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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,906	10/05/2000	Chan Daigle	25791.37.02	8824
27683	7590	03/02/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			NICHOLSON, ERIC K	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/679,906

Applicant(s)

DAIGLE ET AL.

Examiner

Eric K Nicholson

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,28-30,37,40-43 and 45-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,28-30,37,40-43 and 45-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Claim Rejections – 35 USC § 112 1st paragraph**

Claims 1-7,28-30,37,40-43 and 45-76 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon applicant's comparison of the prior art noted in Evans '175 and the claimed invention. Within the remarks made by applicant in the amendment to the claims applicant submits that the Evans device noted on lines 50-55 in column 1 operates differently from the present invention yet it is not disclosed how the present invention is able to operate as a sealed connection after expansion while the Evans disclosure apparently is not. Either the described structure in Evans operates in the same manner as that of the present invention or applicant has not revealed the best mode to allow this post expansion sealing to happen given that applicant has provided no structural differentiation between the present invention and the Evans disclosure. That both have threaded portions connected together with sealant there between of which the connection is then expanded appears not to be disputed, rather it is the outcome after expansion that is disputed, the present invention maintaining a seal and the prior art seemingly not maintaining a seal after expansion. The claimed

result of having the sealant adhere to the threaded portions is a structurally unsupported functional statement that appears not to be constructionally supported. As disclosed on page 7 of the specification the sealing compound can be any one of a number of commercially available sealing compounds therefore how applicant is able to maintain the sealing of the members after expansion does not appear to be in the sealing compound used.

**Claim Rejections – 35 USC § 112 2nd paragraph**

Claims 5,37 and 74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 5,37 and 74 the term “conventional” appears indefinite since what is to be considered “conventional” is subject to change with time and therefore not properly defined. Appropriate correction or explanation is required.

**Claim Rejections – 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,5,28-30,45,46, are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent 6,409,175 to Evans. The Evans patent discloses in column 1, lines 50-55 that it is known to provide a pair of radially expanded tubular members having radially expanded threaded portions coupled to one another with a quantity of sealant from a compound to effect a seal within the radially expanded threaded portions of the radially expanded tubular members wherein the sealant adheres to the radially expanded threaded portions of the radially expanded tubular members. The examiner submits that the described structure in Evans will inherently operates in the same manner as that of the present invention given that applicant has provided no structural differentiation between the present invention and the Evans disclosure. The claimed result of

having the sealant adhere to the threaded portions is a structurally unsupported functional statement that appears to be a wishful result but yet has not been constructionally supported. Further, the claims merely recite that the sealant adheres to the threaded portions of the radially expanded members and does not purport to recite that a seal is maintained. It is submitted by the examiner that the sealant of the Evans disclosure in column 1, lines 50-55 would inherently adhere to the threaded portions. While the Evans disclosure describes the expansion “causing the seal to fail”, this does not speak to the sealant adhering to the threaded portions or not. As applicant knows sealant material is difficult to remove, especially from grooves such as threads, since applicants claims merely recite that the sealant material adheres to the threads and does not recite that a seal between the threads is maintained after expansion it is submitted that the Evans disclosure inherently reads on the amended claims.

Claims 1-6,28-30,45,46,68-71,73 and 74 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,431,831 to Vincent. The Vincent patent discloses a threaded pin and box connection with thread compound “C” there between in the Figure. As disclosed in column 4, lines 15-25 and column 8, lines 5-15 the threaded coupling undergoes expansion and the pipe sealant

maintains sealing integrity under such expansion. As to claims 2-6 see column 4, lines 50-65 continuing on to column 7, lines 1-30.

### **Claim Rejections – 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3,4,6,7 and 68-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,409,175 to Evans et al in view of the Jet-Lok product catalog and applicant's prior art disclosure of Jet-Lok on page 7 of the specification. The Evans disclosure in column 1, lines 50 through 55 as noted above disclose the claimed invention however the features of the sealant compound

are not specified. The Jet-Lok product catalog discloses that is known in the art to use Jet-Lok sealant on threaded pressure fittings, see page 3. Thread sealants are commonly used in the art to aid in locking in sealing threaded connections in order to give resistance to becoming unthreaded due to vibration, high-temperature and pressures. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the sealant compound disclosed in the Evans et al. patent in column 1, lines 50 through 55 with the Jet-Lok sealant, which as noted in the specification includes all the characteristics of the dependent claims 2,3,4,6 and 7 and new claims 68-74. The sealant provides a more secure coupling for the threaded members due to its ability to resist vibrations high temperatures and pressure.

## **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's remarks have been considered however are not deemed to be persuasive. As noted above in the 35 USC 112 first paragraph rejection applicant's remarks in the amendment to the claims submit that the Evans device noted on



lines 50-55 in column 1 operates differently from the present invention. However it is not disclosed why or how the present invention is able to operate as a sealed connection after expansion while the Evans disclosure apparently is not. Either the described structure in Evans operates in the same manner as that of the present invention or applicant has not revealed the best mode to allow this claimed post expansion sealing to happen given that applicant has provided no structural differentiation between the present invention and the Evans disclosure. That both have threaded portions connected together with sealant there between of which the connection is then expanded appears not to be disputed, rather it is the outcome after expansion that is disputed, the present invention maintaining a seal and the prior art seemingly not maintaining a seal after expansion. The claimed result of having the sealant adhere to the threaded portions is a structurally unsupported functional statement that appears to be nothing more than a wishful result. As disclosed on page 7 of the specification the sealing compound can be any one of a number of commercially available sealing compounds therefore how applicant is able to maintain the sealing of the members after expansion does not appear to be in the sealing compound used. Further, the claims merely recite that the sealant adheres to the threaded portions of the radially expanded members and does not purport to recite that a seal is maintained. Thus it is submitted by the examiner that

the sealant of the Evans disclosure in column 1, lines 50-55 would inherently adhere to the threaded portions. While the Evans disclosure describes the expansion "causing the seal to fail", this does not speak to the claimed sealant adhering to the threaded portions or not. As applicant knows sealant material is difficult to remove, especially from grooves such as threads, since applicants claims merely recite that the sealant material adheres to the threads and does not recite that a seal between the threads is maintained after expansion it is submitted that the Evans disclosure inherently reads on the amended claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for Technology Center 3600 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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